

REMARKS

By this Amendment, claims 1, 6, 7, and 9 have been amended. Claims 1-9 are now pending in the Application.

Claims 1, 2, 4, 6-7, and 9 stand rejected under 35 U.S.C. § 103 as being unpatentable over U.S. Patent 5,084,819 to Dewey et al ("Dewey") in view of the McDonnell article "Paying for Health Eager to Control Health-Care Costs" ("McDonnell") and further in view of U.S. Patent 5,712,984 to Hammond et al ("Hammond"). This rejection is respectfully traversed.

The Office Action fails to establish a *prima facie* case of obviousness at least because none of Dewey, McDonnell, and Hammond, even when considered in combination, teach or suggest all of the limitations of independent claims 1, 7, and 9. To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

Claim 1, as amended, recites, *inter alia*, "a display means for displaying a plurality of survey questions pertaining to said individuals' lifestyle, health, and medical tests" and an "entry means for enabling a user to input information into said computer system in response to said plurality of survey questions and for causing said display unit to display said information." Dewey does not teach or suggest these limitations. To the contrary, Dewey teaches inputting data using an "[o]ptical reader 14" that is "adapted to read information from data collection form 18." (column 3, lines 25-26). Furthermore, Dewey teaches away from using a "a display means for displaying a plurality of survey questions" that may be controlled by an "entry means" because Dewey teaches that "most people are reluctant to stand in front of a display screen in public to answer many personal

and private questions” and that “while one individual is busy answering questions others are precluded from utilizing the system and may just walk away without using and perhaps benefiting from such a system.” (column 1, lines 32-40). Neither McDonnell nor Hammond cure the deficiencies of Dewey. Therefore, claim 1 is not obvious over the cited references.

Claim 7, as amended, recites, *inter alia*, “verifying whether at least some of said information is true by comparing said information with additional information acquired from a third party.” Dewey does not teach or suggest this limitation. Instead, Dewey only teaches that “[a]fter the reading data form 18, the system inputs the data to error check unit 34 which verifies that the data form has not been previously submitted to the system and is properly filled out.” (column 3, lines 43-46). Neither McDonnell nor Hammond cure the deficiencies of Dewey. Therefore, claim 7 is not obvious over the cited references.

Claim 9 contains limitations similar to those of claims 1 and 7 and is allowable for the same reasons.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness, at least because the Office Action has not provided proper motivation to combine Dewey with McDonnell. To establish a *prima facie* case of obviousness there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

According to the Office Action, at the time of Applicant’s invention, it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and

insurance risk and to further modify the system of Dewey and McDonnell in combination with the teaching of Hammond to include means for deleting or changing stored gathered information after it has been stored.

Claim 1 recites the use of a computer system “for evaluating insurability of at least one individual.” According to the Office Action, Dewey does not disclose the use of the system for insurable risk assessment. The Office Action relies on McDonnell to cure this deficiency, stating that:

“it would have been obvious to one of ordinary skill in the art to modify the method/system of Dewey with the teaching of McDonnell to use the health assessments to evaluate insurability and insurance risk. As suggested by McDonnell, one would have been motivated to include this feature to slow the growth of healthcare costs (paragraph 2) and to provide insureds with specific health information to reduce insurance costs while improving their health (paragraph 33)”

The motivation to modify Dewey presented in the Office Action is “to slow the growth of healthcare costs, etc.”; however, McDonnell only teaches that getting health assessments may have these effects. The Office Action does not address whether McDonnell makes any suggestion as to the means of providing such an assessment. McDonnell does not suggest there is a problem with the conventional means of providing a health assessment, namely, going to a doctor. McDonnell does teach, however, that motivating payments are made to insureds for going to “get screened for heart disease and cancer risk.” (paragraph 14) Such actions must take place in a hospital or a doctor’s office and do not suggest the use of an automated, remote, Q&A system such as provided by the

present invention, or how to combine a means of providing such information in combination with Dewey. Accordingly, since McDonnell only reports the use of health assessments but teaches towards the use of a hospital/doctor as the means of obtaining the assessment as opposed to using a system such as Dewey, these references provide no teaching of combining the teachings of McDonnell with a computer system for performing the invention as claimed.

The Office Action has not addressed this argument. It should be noted that the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). Dewey does not teach or suggest that the system taught by Dewey may be used in any way with insurance. McDonnell does not teach or suggest any system for reducing insurance premiums that could be combined with the system taught by Dewey. Therefore, neither Dewey nor McDonnell teaches the desirability of combining McDonnell with Dewey.

Furthermore, the Office Action fails to establish a *prima facie* case of obviousness, at least because Dewey teaches away from being combined with Hammond. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983)

Claim 1 recites the use of a computer system comprising a "means for deleting, adding to, or changing said gathered information subsequent to having received and stored said gathered information." According to the Office Action, Dewey in view of McDonnell does not disclose this limitation. The Office Action relies on Hammond to cure this deficiency, stating that:

"It would have been obvious to one of ordinary skill in the art to modify the system of Dewey and McDonnell in combination with the teaching of Hammond to include means for deleting or changing stored gathered information after it has been stored. As suggested by Hammond, one would have been motivated to include this feature to ensure that corrupt data does not continue throughout the analytical process (column 6, lines 14-16)."

However, Dewey specifically teaches away from including a "means for deleting, adding to, or changing said gathered information subsequent to having received and stored said gathered information" at claim 1, where the claim requires a "means for preventing the rereading of user responses." (column 9, line 24). Furthermore, the motivation suggested by the Office Action to "ensure that corrupt data does not continue throughout the analytical process" is not proper or motivating, because Dewey specifically teaches that there is no further analytical process that could be corrupted, and because Dewey's stated objective is to allow "many users to access the system by collecting the data quickly in one transaction" and "immediately generat[ing] and print[ing] user specific recommendations in response to the analyzed data." (emphasis added) (column 1, lines 54-60).

Furthermore, the Office Action has not provided proper motivation to combine Dewey with Hammond because the system taught by Dewey already contains a "means for rejecting an improperly or incorrectly marked data form" (Dewey, column 2, lines 20-21) and therefore does not require the "review process" taught by Hammond (Hammond, column 6, lines 14-16). Hammond states that

"[d]ue to the likelihood that large quantities of data will contain numerous errors, whether reporting, clerical, computational or otherwise, the claim records data must undergo a preliminary quality control analysis which searches the data of each individual claim record for errors. Recognizable errors include variables containing invalid codes, inconsistent codes, improper negative values, illogically high dollar values, etc. For a statistical analyst, or statistician, to become familiar with the data, extensive exposure to the content of the data is required. Questions like the amount of missing data, range of dollar values, diversity in INJURY TYPES, etc., are answered which provide the basis for understanding the underlying nature of the data. This review process assures that corrupt data does not pass by the analyst's scrutiny." (column 6, lines 2-16).

Therefore, it can be seen that the system of Hammond uses complex data forms that can be filled out with an infinite number of possible answers. Dewey, on the other hand, teaches "a system and method which is efficient and allows many users to access the system by collecting the data quickly in one transaction" (column 1, lines 53-56). Furthermore, the forms taught by Dewey may only be answered by multiple choice as shown in TABLE 1, where it can be seen that the instructions instruct a user to "mark correct circles on form" (column 5, lines 10-35). Therefore, because Dewey relies on multiple choice forms, the "error check unit 34 which verifies that the data form has not been previously submitted to the system and is properly filled out" is sufficient to catch any errors that may arise from a user improperly filling out a form. Thus, there is no need and no motivation to combine a complex data review process taught by Hammond with the simple and adequately reviewed system of Dewey.

For at least the above reasons, neither Dewey alone or in combination with McDonnell and Hammond teach or suggest the limitations of claims 1, 7, and 9. Claims 2, 4, and 6 depend on claim 1 and are allowable for the same reasons. Accordingly, Applicant respectfully requests that the rejection be withdrawn and the claims allowed.

Claim 3 stands rejected under 35 U.S.C. 103(a) as being unpatentable over the combination of Dewey, McDonnell, and Hammond in view of U.S. Patent 4,975,840 to DeTore et al. ("DeTore"). This rejection is respectfully traversed. Claim 3 depends from claim 1 and thus recites the limitations of claim 1. As described above, there is no suggestion or motivation to combine Dewey and McDonnell or Dewey and Hammond, and Dewey in view of McDonnell and Hammond fails to teach or suggest the limitations of claim 1. Furthermore there is no suggestion or motivation in the prior art to combine DeTore with Dewey, McDonnell, and Hammond. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

Claim 5 stands rejected as being unpatentable over Dewey and McDonnell and in further view of the Lynch article "Stay Healthy: Pay Le\$\$ for Health Insurance" ("Lynch"). This rejection is respectfully traversed. Claim 5 depends from claim 1 and thus recites the limitations of claim 1. However, Lynch fails to overcome the above-noted deficiencies of Dewey, McDonnell, and Hammond. Therefore, Applicant respectfully requests that this rejection be withdrawn.

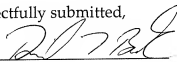
Claim 8 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Dewey in view of McDonnell, Hammond, and DeTore. This rejection is respectfully traversed. Claim 8 depends from claim 7 and thus recites the limitations of claim 7. As described above, there is no suggestion or motivation to combine Dewey and McDonnell or Dewey

and Hammond, and Dewey in view of McDonnell and Hammond fails to teach or suggest the limitations of claim 1. Furthermore there is no suggestion or motivation in the prior art to combining DeTore with Dewey, McDonnell, and Hammond. Accordingly, Applicant respectfully requests that this rejection be withdrawn.

In view of the above amendment, Applicant believes the pending application is in condition for allowance.

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